

15 MAR 2007



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In re Application of
OKUMURA, et al.
Serial No.: 10/577,877
PCT No.: PCT/JP04/15520
Int. Filing Date: 20 October 2004
Priority Date: 11 November 2003
Atty Docket No.: 403695/SOEI
For: A RUST-PREVENTIVE WATER-OIL
SEPARATING CLEANER COMPOSITION AND
A CLEANING METHOD USING THE SAME

DECISION ON PETITION

UNDER 37 CFR 1.47(a)

This decision is in response to the petition under 37 CFR 1.47(a) filed 06 July 2005 to accept the application without the signature of joint inventor Masahiro Makino. As authorized, the \$200.00 petition fee will be charged to Deposit Account No.: 12-1216.

BACKGROUND

On 20 October 2004, applicant filed international application PCT/JP04/15520 which claimed priority to a previous application filed 11 November 2003. A copy of the international application was transmitted to the United States on 19 May 2005. Pursuant to 37 CFR 1.495 the period for providing payment of the full, U.S. Basic National Fee was set to expire thirty months from the priority date, or midnight 11 May 2006.

On 28 April 2006, applicant filed a transmittal letter for entry into the national stage in the United States, which was accompanied by the requisite basic national fee as required by 35 U.S.C. 371(c)(1); an English translation of the international application as filed; an Application Data Sheet; an Information Disclosure Statement and a preliminary amendment.

On 05 March 2007, applicant was mailed a "Notification of Missing Requirements" (Form PCT/DO/EO/905) indicating that an executed oath or declaration of the inventors was required, as well as, payment of the \$130.00 surcharge for providing an executed oath or declaration later than thirty months from the earliest claimed priority date. Applicant was afforded two months to file a proper response.

On 08 March 2007, applicant filed the present petition under 37 CFR 1.47(a).

DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by (1) the fee under 37 CFR 1.17(g), (2) factual proof that the missing joint investor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor. Applicant has satisfied items 1, 3 and 4.

As to item (2), applicant has provided an email from the non-signing inventor Mr. Makino indicating that he will not execute the declaration. This email was sent in response to an email request which included a copy of the description and the claims of the subject invention. However, before this item can be considered satisfied some additional clarification is required. The original emails were in Japanese and while applicant has included English translations, applicant has not included a signed statement from the individual who provided the translations attesting to that individual's competency in Japanese and English, as well as, the validity of the English translations. This is especially important in the case at hand when the written refusal of Mr. Makino is an English translation.

Similarly, there is a question as to the copy of the application papers provided to the non-signing inventor. Since MPEP 409.03(d) requires that before a refusal can be alleged a complete set of application papers must be provided to the inventor, applicant should confirm that the papers identified in the email as English application and preliminary amendment were provided to Mr. Makino in a language he could understand.

In light of the above, it is not possible to grant applicant's petition at this time.

CONCLUSION

For the reasons stated above, applicant's petition under 37 CFR 1.47(a) is **DISMISSED without prejudice.**

Any reconsideration on the merits of this petition must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)." No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be directed to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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